

REMARKS/ARGUMENTS

Claims 1-22 were pending in the present application. Claims 17-19 and 22 have been withdrawn. By virtue of this response, claim 15 has been amended. Accordingly, claims 1-22 are currently under consideration. Amendment and cancellation of certain of the claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

The amendment to claim 15 is fully supported by the original specification. Therefore, no new matter is added.

Amendments

Claim 15 was amended to recite that the microorganism is selected from the bacteria, fungi or parasites. Support for this amendment is found in Applicants' specification at, for example, page 41, lines 24-28.

The Abstract was amended to correct a grammatical error kindly noted by the Examiner.

These amendments have been made in accordance with 37 C.F.R. § 1.121 as amended on November 7, 2000. As required, attached hereto is an appendix illustrating these amendments.

Entry of these amendments is earnestly solicited.

Election in Response to Restriction Requirement/Election of Species Requirement

Applicants hereby confirm their election of Group I, Claim 1-16 and the species of compound 177. As noted in the Office Action, Claims 20-21 have been combined into Group I and Group I as now cast includes Claims 1-16 and 20-21.

Notwithstanding the above, Applicants' election did not include a recasting of generic Claim 1 as found in the Office Action and for reasons set forth below, Applicants traverse this recasting of their generic claim.

Recasting of Claim 1 into Different Groups is Inconsistent with the Patent Office's Stated Guidelines Regarding Restriction of Markush Groups.

In recasting Claim 1 as per the Office Action, the Examiner has divided Applicants' Claim 1 into different alternative Markush Groups. However, such recasting of a claim is improper because

it is inconsistent with the applicable case law and with the Patent Office's stated guidelines for treatment of Markush groups as set forth in MPEP § 803.02.

Specifically, in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978), the court articulated the general proposition that:

[A]n applicant has the right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. *Id.* At 331. (Emphasis in original).

In view of the above and similar case law, the Patent Office has set forth the following general policy regarding restriction of Markush-type claims in MPEP § 803.02:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334, it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984).

In the present case, the Patent Office has refused to examine Claim 1 in the form Applicants consider to best define their invention and has instead required Applicants to elect only a dissected portion of these claims for prosecution. Such a requirement is clearly improper in view of the applicable case law and the stated policy of the Patent Office. Accordingly, in view of the above, Applicants respectfully request that the USPTO examine the entirety of Claim 1 as presented.

Rejection Under 35 U.S.C. § 112, first paragraph

Claim 15 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to describe to the skilled artisan how to make and use the claimed invention. Specifically, the Office

Action alleges that to practice the claimed invention would entail undue experimentation. For the following reasons, the rejection is traversed.

The Examiner has based this assertion on the allegation that the “[p]rior arts do not indicate “which diseases caused by pathogenic organisms” may be treated by the claimed compound. There is little predictability in the art of which modifications may be made to the claimed compounds which would retain it’s ability to be useful in treating diseases caused by pathogenic organisms.”¹

Applicants submit that the amendments made to Claim 15 obviate this rejection and, accordingly, withdrawal of this rejection is requested.

Rejection Under 35 U.S.C. § 112, second paragraph

Claim 16 stands rejected under 35 U.S.C. § 112, second paragraph, because the specification allegedly does not recite that cancer as a disease caused by a pathogenic organism. This rejection is respectfully traversed and Applicants direct the Examiner’s attention to page 41, lines 24-28, which correlate cancer with bacterial, fungal and/or parasitic infections.

Withdrawal of this rejection is requested.

Objection to the Abstract

The Abstract stands objected to because of the presence of grammatical errors. Applicants submit that this objection has been obviated by the amendments to the Abstract.

Withdrawal of this objection is requested.

¹ See page 4, second full paragraph of the specification.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Notwithstanding the above, and in order to avoid unintended abandonment of this application, enclosed herewith is a Notice of Appeal.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant(s) petition(s) for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 554912000200.

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Respectfully submitted,

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